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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/607,888 | 06/27/2003 | Kate O'Hara | 100041-41191 | 7243 |

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EXAMINER

CARTER, MONICA SMITH

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3722

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/607,888

Applicant(s)

O'HARA, KATE

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-20 and 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-8, 10-12 and 42-44 is/are allowed.
- 6) ☒ Claim(s) 13-20 and 22-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-17, 19, 20, 22-32 and 34-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman ('841) in view of Pitts (4,629,349).

Friedman discloses a notebook comprising a stack of papers (38); and a pouch (10) having generally the same size and shape in top view as the stack of papers (as seen in figure 2), the pouch including an inner cavity (as seen in figure 1); the pouch being generally rectangular in top view (as seen in figure 2) and including a pair of lateral edges and a pair of longitudinal edges; wherein the pouch is bound to the stack of papers along one of the lateral edges (see figure 2).

Friedman discloses the claimed invention except for the claimed dimensions of the pouch. It would have been an obvious matter of design choice to provide any desired dimensions for the pouch, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as

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being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Friedman discloses the claimed invention except for explicitly disclosing the pouch being generally transparent. Friedman discloses the pouch being "made from a variety of materials as heavy paper bond, drafting board, inexpensive plastic sheet material and the like" (see col. 3, lines 29-37). Inherently, this would include a material rendering the pouch generally transparent. Furthermore, Pitts discloses that it is known to provide loose-leaf notebooks designed of flexible transparent material (see column 1, lines 60-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the notebook of Friedman of a generally transparent material, as taught by Pitts, to enable the contents of the notebook to be visible when the notebook is in a closed position.

Regarding claim 14, see the above rejections to claim 13.

Regarding claim 15, Friedman, as modified by Pitts, discloses the notebook including a binding mechanism (36) binding together the stack of papers and the pouch.

Regarding claim 16, Friedman, as modified by Pitts, discloses the binding mechanism being a spiral binding mechanism (as seen in figure 2 of Friedman).

Regarding claim 17, Friedman, as modified by Pitts, discloses at least part of the binding mechanism extending through the stack of papers and the pouch to bind the stack of papers and the pouch (as seen in figure 2 of Friedman).

Regarding claim 19, Friedman, as modified by Pitts, discloses the notebook including a rear cover (45) bound to the stack of papers and the pouch by the binding

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mechanism (as seen in figure 2 of Friedman), the rear cover having a greater stiffness than a paper of the stack of papers (see col. 3, lines 26-28 of Friedman).

Regarding claim 20, Friedman, as modified by Pitts, discloses the rear cover being bound to the stack of papers and the pouch such that the stack of papers can be located between the pouch and the rear cover (as seen in figure 2 of Friedman— the stack of papers 38 are between the rear cover 45 and the pouch 10).

Regarding claim 22, Friedman, as modified by Pitts, discloses the pouch including a pair of opposed panels (12, 14) joined together at their outer peripheries to form a cavity therebetween (see col. 3, lines 38-68 through col. 4, lines 1-7 of Friedman).

Regarding claim 23, see the above rejections to claim 13.

Regarding claim 24, Friedman, as modified by Pitts, discloses the pouch including a mouth (22) for accessing the inner cavity.

Regarding claim 25, Friedman, as modified by Pitts, discloses the pouch including a closure mechanism (40, 42) for selectively closing and opening the mouth.

Regarding claim 26, see the above rejections to claim 13. Further, Friedman, as modified by Pitts, discloses the pouch being “made from a variety of materials as heavy paper bond, drafting board, inexpensive plastic sheet material and the like” (see col. 3, lines 29-37). Inherently, this would the pouch being made of a flexible material.

Regarding claim 27, Friedman, as modified by Pitts, discloses the pouch being generally aligned with the stack of papers such that the longitudinal and lateral edges of

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the pouch are aligned with a pair of longitudinal and lateral edges of the papers (as seen in figure 2 of Friedman).

Regarding claim 28, Friedman, as modified by Pitts, discloses a generally transparent notebook having a stack of papers (38) and a pouch (10) bound to the stack of papers (as seen in figure 2 of Friedman), the pouch including an inner cavity for storing objects.

Regarding claims 29-31, see the above rejections.

Regarding claim 32, Friedman, as modified by Pitts, discloses the binding mechanism being a spiral binding mechanism (as seen in figure 2 of Friedman).

Regarding claim 34, Friedman, as modified by Pitts, discloses the notebook including a rear cover (45) bound to the stack of papers and the pouch by the binding mechanism (as seen in figure 2 of Friedman), the rear cover having a greater stiffness than a paper of the stack of papers (see col. 3, lines 26-28 of Friedman).

Regarding claim 35, Friedman, as modified by Pitts, discloses the rear cover being bound to the stack of papers and the pouch such that the stack of papers can be located between the pouch and the rear cover (as seen in figure 2 of Friedman— the stack of papers 38 are between the rear cover 45 and the pouch 10).

Regarding claim 36, Friedman, as modified by Pitts, discloses the pouch including a pair of opposed panels (12, 14) joined together at their outer peripheries to form a cavity therebetween (see col. 3, lines 38-68 through col. 4, lines 1-7 of Friedman).

Regarding claim 37, see the above rejections to claim 13.

Regarding claim 38, Friedman, as modified by Pitts, discloses the pouch including a mouth (22) for accessing the inner cavity.

Regarding claim 39, Friedman, as modified by Pitts, discloses the pouch including a closure mechanism (40, 42) for selectively closing and opening the mouth.

Regarding claim 40, Friedman, as modified by Pitts, discloses the pouch being generally rectangular in top view and including a pair of lateral and longitudinal edges (as seen in figures 1 and 3 of Friedman), wherein the pouch is bound to the stack of papers along one of the lateral edges (as seen in figure 2 of Friedman).

Regarding claim 41, Friedman, as modified by Pitts, discloses the pouch being generally aligned with the stack of papers such that the longitudinal and lateral edges of the pouch are aligned with a pair of longitudinal and lateral edges of the papers (as seen in figure 2 of Friedman).

4. Claims 18 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Pitts and further in view of Robinson ('207).

Friedman, as modified by Pitts, discloses the claimed invention except for the stack of papers including a plurality of printed guidelines.

Robinson discloses a notebook having a stack of papers, wherein the stack of papers includes a plurality of printed guidelines (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to

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modify Friedman's invention to include printed guidelines on the stack of papers, as taught by Robinson, to enable the user to provide printed indicia on the papers in a neat and orderly fashion.

Allowable Subject Matter

5. Claims 1-3, 5-8, 10-12 and 42-44 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 13-20 and 22-41 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Friedman fails to disclose a generally transparent notebook. The examiner asserts that while Friedman does not explicitly disclose the notebook being made of a generally transparent material, Friedman, as modified by Pitts, does disclose notebooks made of generally transparent material as set forth above. In column 1, lines 60-67, Pitts discloses the use of transparent material for fabricating a notebook. It would have been, therefore, obvious to provide the notebook of Friedman of a generally transparent material to enable the contents disclosed therein to be easily viewed when the notebook is in a closed position.

For the reasons as set forth above, the rejections are maintained.

C nclusi n

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Abbott discloses a transparent notebook.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2005

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER